

REMARKS

Claim Amendments:

Claim 4 has been amended to delete a redundant density limitation.

Information Required by 37 C.F.R. §1.607(a)

The information required by 37 C.F.R. §1.607(a) is set forth under headings which correspond to the subsections of §1.607 to facilitate consideration by the Examiner.

IDENTIFICATION OF THE PATENTS

The patent which claims subject matter which interferes with the subject matter claimed in the present application is U.S. Patent No. 6,416,739 to Rogerson et al. ("the Rogerson Patent").

The Rogerson Patent was issued on July 9, 2002, from application Serial No. 09/582,145, which is a national phase application of PCT/GB98/03853, filed December 21, 1998. The PCT application claims priority to GB application Serial No. 9727102, filed December 22, 1997.

Quadrant Healthcare (UK) Limited is the assignee named on the face of the patent.

1. PRESENTATION OF PROPOSED COUNTS

Attached Appendix A sets forth two proposed Counts both of which are alternative Counts prepared after consideration of the subject matter claimed by the respective parties. Proposed Count A contains Claims 2, 10, 12, and 19 of the instant application and Claims 6, 14, 22, and 36

of the Rogerson Patent, joined by “or.” Proposed Count B contains Claims 6, 16 and 23 of the instant application and Claims 8, 24 and 38 of the Rogerson Patent and a claim which corresponds exactly to Claim 24 of the instant application and Claim 39 of the Rogerson Patent, joined by “or.” As defined by the proposed Counts, the interfering subject matter of the parties is directed to hollow microspheres suitable for pulmonary delivery of a bioactive agent, which microspheres have a low bulk density, and methods for their use and preparation.

Appendix C sets forth a comparison of the claims of the instant application and the Rogerson Patent which form a part of each proposed Count for the convenience of the Examiner.¹

2. IDENTIFICATION OF CLAIMS OF THE ROGERSON PATENT
WHICH CORRESPOND TO THE PROPOSED COUNTS

All the claims (Claims 1-41) of the Rogerson Patent are believed to correspond to the proposed Counts. In order to assist the Examiner, attached Appendix D sets forth a detailed comparison of the claims of the Rogerson Patent with the proposed Counts.

3. CLAIMS OF THE TARARA APPLICATION WHICH CORRESPOND TO THE
PROPOSED COUNTS

¹ Dependent claims of the Rogerson Patent have been presented in independent form to include all limitations of their base claim and any intervening claims for ease of comparison.

Appendix B is a chart providing an element-by-element recitation of Claims 2-28 of the Tarara Application and an indication of the passages in the originally filed application² where, at the very least, the claims find support.

Claims 2-28 of the Tarara Application are believed to correspond to the proposed Counts. To further assist the Examiner, Applicants attach Appendix E. Appendix E is a detailed comparison of the claims of the instant application with the proposed counts.

4. EXPLANATION OF HOW THE REQUIREMENT OF 35 U.S.C. §135(b) IS MET

According to 35 U.S.C. §135(b), “[a] claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.” In the instant case, the Rogerson Patent issued July 9, 2002. As the present application was filed before July 9, 2003 with claims which met the requirement of 35 U.S.C. §135(b), a claim

² The present Tarara application is a continuation of application Serial No. 09/886,296, filed June 21, 2001, which is a divisional of application Serial No. 09/219,736, filed December 22, 1998, which is a continuation of PCT/US98/20602, filed September 29, 1998, which is a continuation-in-part of application Serial No. 09/133,848, filed August 14, 1998, which is a continuation-in-part of application Serial No. 09/106,932, filed June 29, 1998, which claims benefit of application Serial No. 60/060,337, filed September 29, 1997. Accordingly, Tarara should be accorded benefit of the September 29, 1997 prior application in the declaration of interference. Tarara should also be designated as the senior party in the interference as having the earlier effective filing date.

which is the same as, or for the same or substantially the same subject matter as, a claim of the Rogerson Patent was present prior to one year from the date on which the Rogerson Patent issued.

Conclusions:

In view of the above amendments and remarks, Applicants submit that the all the claims of this application are patentable.

Accordingly, Applicants respectfully request that an interference be declared employing the proposed Counts set forth in attached Appendix A with Claims 2-28 of the Tarara Application and Claims 1-41 of the Rogerson Patent designated as corresponding to the Count. Such action is respectfully requested.

Respectfully submitted,

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